

**REMARKS**

The above-referenced application has been reviewed in light of the Office Action mailed November 9, 2004. By the present amendment, the Applicant has amended claims 1, 3, 8, 10, 11, 13, 15, 17, 18, 20, 21, 25-30, 32, 35-42, 48-50, 57-60, 77, 79, 84, 95, and 100. Claims 6, 24, and 80 have been canceled. Claims 7, 9, 12, 14-19, 43-47, 53-55, 64, 65, 85-88, 95, and 96 were withdrawn in the Office Action as being drawn to a non-elected species. It is respectfully submitted that the claims pending in the application do not introduce new subject matter, are fully supported by the specification, and are patentable over the prior art. Prompt and favorable consideration of these claims is earnestly sought.

The Office Action stated that copies of the Foreign Patents and Other Documents cited in the Information Disclosure Statement filed on March 5, 2004 are not present in Application Serial No. 10/662,923. In the interests of expediting the prosecution of the subject application, copies of the foreign patents and other documents are enclosed for the Examiner's convenience along with the pages of form SB/08 listing the enclosed references. It is respectfully requested that the Examiner consider the enclosed references and initial the enclosed pages of the SB/08 form.

In the Office Action, claim 80 was rejected under 35 U.S.C. § 112. By the present amendment, the Applicant has canceled claim 80 and it is respectfully requested that the rejection of the Office Action be withdrawn.

In the Office Action, claims 11, 60, and 84 were rejected under 35 U.S.C. § 112 for indefiniteness. The Office Action stated that there was no antecedent basis for the recitation of "the bladder" in claim 11. As presently amended, claim 11 recites "the expandable

bladder." Claim 11 depends indirectly from amended claim 1 that recites "an expandable bladder" thereby providing antecedent basis for the recitation of "the expandable bladder" in amended claim 11. Claim 60 has been amended to recite "unconfined fluid in the joint" as opposed to "unconfined pressure in the joint." Claim 84 has been amended to depend from claim 83 thereby providing antecedent basis for the recitation of "the tissue." It is respectfully submitted that the rejections of the Office Action have been overcome.

In the Office Action, claims 1, 6, 8, 10, 11, 13, 27-30, 38-42, 48-51, 59-62, 66-70, 72, and 73 were rejected under 35 U.S.C. § 102 (b) as anticipated by or, in the alternative under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 3,417,745 to Sheldon (the '745 patent). The Office Action stated that the '745 patent discloses the steps of providing a retractor having a distal portion and an expandable body coupled to the distal portion, positioning the expandable body between adjacent vertebrae and expanding the expandable body to spread the adjacent vertebrae apart.

As presently amended, claims 1, 27, and 38 recite a method including, *inter alia*, providing a retractor having "an expandable bladder," while claim 59 recites a method including, *inter alia*, introducing "a bladder into the joint." Further still, claims 1 and 27 recite "inflating the expandable bladder to spread the adjacent vertebrae apart," claim 38 recites "inflating the expandable bladder to spread the adjacent surfaces apart," and claim 59 recites "inflating the bladder such that the bladder engages the adjacent surfaces and distends the joint to enlarge the space."

The '745 patent relates to a housing having two inflatable members attached to a distal region thereof. The housing is adapted for receiving an endoscope therein. Specifically, the

inflatable members of the '745 patent are adapted for urging soft tissue away from the distal end of the housing allowing an improved view of the area through the endoscope. According to the '745 patent, "inflation of the member 57 causes separation of the examined part from the distal end of the spinescope. This allows proper functioning of the optical system. After this has been accomplished the spinescope may be advanced into the newly created space" (Column 9, lines 5-9). In addition, the '745 patent continues (Column 9, lines 10-23) and states that the

inflatable member 57 is attached at the collar 58 which fits the distal end of the spinescope snugly and is not in a fixed but a slidable relationship to the spinescope. This allows to push the spinescope forward and place it in the space created by the pressure of the member 57. A second inflatable member 57a mounted distally of the member 57 is now inflated and produces a new space into which the spinescope may be further advanced. In this way the parts which do not have a hollow space may be examined step by step. This is the situation in the extra-dural space in the spinal canal which normally does not have any open space but only a potential space to be created by a pressure against the organs which occupy it.

Therefore, the '745 patent does not disclose or suggest a method including, *inter alia*, "inflating the expandable bladder to spread the adjacent vertebrae apart" as recited in amended claims 1 and 27, "inflating the expandable bladder to spread the adjacent surfaces apart" as recited in amended claim 38, or "inflating the bladder such that the bladder engages the adjacent surfaces and distends the joint to enlarge the space" as recited in amended claim 59 and the rejection of the Office Action has been overcome.

Claim 6 has been canceled and it is respectfully requested that the rejection of this claim be withdrawn. Since claims 8, 10, 11, and 13 depend from amended claim 1, claims 28-30 depend from amended claim 27, claims 39-42 and 48-51 depend from amended claim 38, and claims 60-62, 66-70, 72, and 73 depend from amended claim 59, it is respectfully submitted that the rejection of these claims have also been overcome.

In the Office Action, claims 2-5, 20-26, 31-37, 52, 63, 71, 74, 78-80, 82-84, 89-94, and 97-101 were rejected under 35 U.S.C. § 103 (a) as obvious over the '745 patent. The Office Action stated that the '745 patent does not specifically disclose operating on a herniated disc, but asserted that it would have been obvious to remove the herniated disc during the procedure disclosed in the '745 patent. In addition, the Office Action stated that it would have been obvious to apply a vacuum to the bladder for quickly deflating it.

As discussed hereinabove, the '745 patent relates to a device adapted for urging soft tissue away from the distal end of an endoscope and does not anticipate or suggest the method recited in amended claim 1. Since claims 2-5 depend from amended claim, it is respectfully submitted that claims 2-5 are allowable over the prior art.

Amended claim 20 recites a method including, *inter alia*, providing a retractor having "an expandable bladder coupled to the distal portion" of the retractor and "inflating the expandable bladder to spread the adjacent vertebrae apart." As discussed hereinabove, the '745 patent does not suggest a method including an expandable bladder and "inflating the expandable bladder to spread the adjacent vertebrae apart." Therefore, it is respectfully submitted that the method recited in amended claim 20 is not suggested by the '745 patent and the rejection of the Office Action has been overcome.

Claims 21-23, 25, and 26 depend from amended claim 20 and it is respectfully submitted that these claims are also allowable over the prior art. Claim 24 has been canceled and it is respectfully requested that the rejection of this claim be withdrawn.

Claim 78 recites a method for working within a bone joint including, *inter alia*, "providing a retractor having an expandable bladder" and "inflating the expandable bladder to

spread the adjacent surfaces to enlarge a working space in said joint." As discussed hereinabove, the '745 patent relates to a device adapted for urging soft tissue away from the distal end of an endoscope and does not suggest the method recited in claim 78. Therefore, it is respectfully submitted that claim 78 is not suggested by the '745 patent. Since claims 79, 80, 82-84, 89-94, and 97-101 depend from claim 78, it is respectfully submitted that these claims are also allowable over the prior art.

As discussed hereinabove, amended claims 27, 38, and 59 are not anticipated or suggested by the '745 patent. Since, claims 31-37 depend from amended claim 27, claim 52 depends from amended claim 38, and claims 63, 71, and 74 depend from amended claim 59, it is respectfully submitted that these claims are also allowable over the prior art.

The Office Action rejected claims 56-58, 75-77, and 81 under 35 U.S.C. § 103 (a) as obvious over the '745 patent in view of U.S. Patent No. 4,501,266 to McDaniel (the '266 patent). According to the Office Action, the '745 patent does not disclose that the device may be used in a knee, but that the '266 patent discloses that the knee is an area of the body requiring surgical intervention and stated that it would have been obvious to use the device of the '745 patent in a knee. Claims 56-58 depend from amended claim 38, claims 75-77 depend from amended claim 59, and claim 81 depends from claim 78. As discussed hereinabove, the '745 patent does not anticipate or suggest the method recited in amended claims 38 and 59, and does not suggest the method recited in claim 78. Adding the disclosure of the '266 patent does not overcome the deficiencies of the '745 patent and does not suggest a method including "providing a retractor having an expandable bladder" and "inflating the expandable bladder to spread the adjacent surfaces apart" as recited in amended claim 38, "inflating the bladder such that the bladder

engages the adjacent surfaces and distends the joint to enlarge the space" as recited in amended claim 59, or "inflating the bladder to spread the adjacent surfaces to enlarge a working space in said joint" as recited in amended claim 78. Therefore, it is respectfully submitted that these claims are also allowable over the prior art.

The Office Action rejected claims 1, 2, 4, 5, and 10 under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 3,916,907 to Peterson (the '907 patent). According to the Office Action, the '907 patent discloses the steps of providing a retractor having a distal portion and an expandable body coupled to the distal portion, positioning the expandable body between adjacent vertebrae, and expanding the expandable body to spread the adjacent vertebrae apart. The Office Action also stated that the '907 patent discloses removing the intervertebral disc.

As presently amended, claim 1 recites a method including, *inter alia*, providing a retractor having "an expandable bladder" and "inflating the expandable bladder to spread the adjacent vertebrae apart." The device disclosed in the '907 patent relates to a spreader instrument having pivotably connected arms. The '907 patent does not anticipate or suggest a method including providing a retractor having an "expandable bladder" and "inflating the expandable bladder to spread the adjacent vertebrae apart" as recited in amended claim 1. Therefore, it is respectfully submitted that the rejection of the Office Action has been overcome. Since claims 2, 4, 5, and 10 depend from amended claim 1, it is respectfully submitted that these claims are also allowable over the prior art.

Claims 15-19, 47, 53-55, 64, 65, 95, 96 were withdrawn as being drawn to a non-elected species. As presently amended, claims 1, 38, 59, and 78 are generic to all species. The Applicant respectfully requests consideration of these claims in view of the present amendments

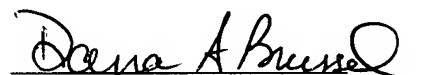
Appl. No. 10/729,668  
Amdt. dated March 18, 2005  
Reply to Office Action mailed November 9, 2004

and remarks.

The Office Action rejected claims 1-6, 8, 10, 11, 13, 20-42, 48-52, 56-63, 66-84, 89-94, and 97-101 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,017,305. The Applicant will submit a suitable terminal disclaimer upon indication that claims 1-5, 8, 10, 11, 13, 20-23, 25-42, 48-52, 56-63, 66-84, 89-94, and 97-101 are otherwise allowable.

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims pending in the application, namely claims 1-5, 8, 10, 11, 13, 15-23, 25-42, 47-79, 81-84, and 89-101, are in condition for allowance. Should the Examiner desire a telephonic interview to resolve any outstanding matters, he is sincerely invited to contact the undersigned at (631) 501-5713.

Respectfully submitted,

  
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